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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,140	06/08/2001	Yoshihiko Hotta	65246 CCD	1290

7590 11/06/2003

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1185 Ave. of the Americas
New York, NY 10036

EXAMINER

HESS, BRUCE H

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 11/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/877,140

Applicant(s)

Hotta et al.

Examiner

Bruce Hess

Group Art Unit

1774

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 8-7-03 (Election)

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-26 is/are pending in the application.
- Of the above claim(s) 24-26 is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☐ Claim(s) is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 4-6
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit: 1774

1. The restriction/election requirement of Paper No. 8 is adhered to and made final for the reasons of record.
2. Claims 1-15 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over the patent to Tsutsui et al (JP 10-016409).
3. Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the patent to Tsutsui et al in view of the patent to Hotta et al (EP 0,891,875 A2).

Tsutsui et al teach a thermo reversible recording medium comprising a substrate and a heat sensible layer containing resin and a carboxyl group free linear hydrocarbon-containing compound (A) having a urethane band. Another linear hydrocarbon-containing compound (B) free of carboxyl groups and having a lower melting point than compound (A) can also be present. The experimental modification of this prior art in order to ascertain optimum-operating conditions (e.g., determine specific melting points and compositional proportions) fails to render applicants' claims patentable in the absence of unexpected results.

Hotta et al teach that a thermo reversible recording medium is conventionally employed in the form of a label, card, disk, disk cartridge or tape cartridge. Use of the Tsutsui et al recording media in the conventional forms taught by Hotta et al would have been obvious to one of ordinary skill in this art in the absence of unexpected results.



BRUCE H. HESS
PRIMARY EXAMINER